UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,645	08/07/2001	Kotaro Yamaguchi	35.C15656	9249

5514	7590	12/15/2004	

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EXAMINER
LETT, THOMAS J

ART UNIT	PAPER NUMBER
2626	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/922,645	YAMAGUCHI, KOTARO
	Examiner	Art Unit	
	Thomas J. Lett	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 August 2004</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,10-17,20-27,30-37, and 40* is/are rejected.

7)☒ Claim(s) *8,9,18,19,28,29,38, and 39* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>07 August 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☒ All b)☐ Some * c)☐ None of:

   1.☒ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
  Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1.   Claims 1-7, 10-17, 20-27, 30-37, and 40 are rejected under 35 U.S.C. 102(e) as

being anticipated by Horvitz (US 2004/0236719 A1). Horvitz discloses an E-mail

printing apparatus (e.g., computerized device 100) comprising:

receiving means for receiving E-mail (first program 400 that includes an

electronic mail program that receives e-mail, para. 0149, lines 1-3); and

limiting means for limiting a print of the E-mail received by said receiving means

(mechanism 402 can truncate each message to a predetermined length, para. 0149,

lines 7-10).

With respect to claim 2, Horvitz discloses a limiting means prints the E-mail up to

a predetermined amount (mechanism 402 can truncate each message to a

predetermined length, para. 0149, lines 7-10).

With respect to claim 3, Horvitz discloses a predetermined amount includes the

number of lines (mechanism 402 can truncate each message to a predetermined

length, para. 0149, lines 7-10).

With respect to claim 4, Horvitz discloses discriminating means (mechanism 402 may include a text classifier) for discriminating whether the E-mail exceeds a predetermined amount or not, and wherein said limiting means limits the print in accordance with a result of the discrimination by said discriminating means (mechanism 402 can truncate each message to a predetermined length, para. 0149, lines 7-10).

With respect to claim 5, Horvitz discloses a setting means for setting said predetermined amount (prioritization of a text based on a predetermined criteria given a constrained resource is accomplished via a text classifier para. 0052, lines 1-2).

With respect to claim 6, Horvitz does not specifically disclose that when "0" is set by said setting means, said limiting means does not limit the print of the E-mail. Horvitz does disclose using a text classifier to prioritize the text message to a constrained output such as a printer (para. 0145, lines 7-9).

With respect to claim 7, Horvitz does not specifically disclose that a limiting means does not print the E-mail exceeding a predetermined amount but prints the E-mail which does not exceed the predetermined amount. Horvitz does disclose using a text classifier to prioritize the text message to a constrained output such as a printer (para. 0145, lines 7-9).

With respect to claim 10, Horvitz discloses printing means for printing the E-mail received by said receiving means (device 100 may indicate output to the user via other output device(s) 114, e.g., printers, para. 21, lines 17-19, using a first program 400 that includes an electronic mail program that receives e-mail, para. 0149, lines 1-3).

Claim 11 is a method claim and is rejected for the same reasons as that of claim

1.

Claim 12 is a method claim and is rejected for the same reasons as that of claim

2.

Claim 13 is a method claim and is rejected for the same reasons as that of claim

3.

Claim 14 is a method claim and is rejected for the same reasons as that of claim

4.

Claim 15 is a method claim and is rejected for the same reasons as that of claim

5.

Claim 16 is a method claim and is rejected for the same reasons as that of claim

6.

Claim 17 is a method claim and is rejected for the same reasons as that of claim

7.

Claim 20 is a method claim and is rejected for the same reasons as that of claim

10.

Claim 21 is a program claim and is rejected for the same reasons as that of claim

1.

Claim 22 is a program claim and is rejected for the same reasons as that of claim

2.

Claim 23 is a program claim and is rejected for the same reasons as that of claim

3.

Claim 24 is a program claim and is rejected for the same reasons as that of claim 4.

With respect to claim 25, Horvitz discloses a setting step of setting said predetermined amount (prioritization of a text based on a predetermined criteria given a constrained resource is accomplished via a text classifier para. 0052, lines 1-2).

With respect to claim 26, Horvitz does not specifically disclose that when "0" is set by said setting step, the print of the E-mail is not limited in said limiting step. Horvitz does disclose using a text classifier to prioritize the text message to a constrained output such as a printer (para. 0145, lines 7-9).

Claim 27 is a program claim and is rejected for the same reasons as that of claim 7.

Claim 30 is a program claim and is rejected for the same reasons as that of claim 10.

Claim 31 is a medium claim and is rejected for the same reasons as that of claim 1.

Claim 32 is a medium claim and is rejected for the same reasons as that of claim 2.

Claim 33 is a medium claim and is rejected for the same reasons as that of claim 3.

Claim 34 is a medium claim and is rejected for the same reasons as that of claim 4.

With respect to claim 35, Horvitz discloses a setting step of setting said predetermined amount (prioritization of a text based on a predetermined criteria given a constrained resource is accomplished via a text classifier para. 0052, lines 1-2).

With respect to claim 36, Horvitz does not specifically disclose that when "0" is set by said setting step, the print of the E-mail is not limited in said limiting step. Horvitz does disclose using a text classifier to prioritize the text message to a constrained output such as a printer (para. 0145, lines 7-9).

Claim 37 is a medium claim and is rejected for the same reasons as that of claim 7.

Claim 40 is a medium claim and is rejected for the same reasons as that of claim 10.

Allowable Subject Matter

2.   Claims 8-9, 18-19, 28-29, and 38-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

With respect to claims 8, 18, 28, and 38, the Examiner found neither prior art cited in its entirety, nor based on the prior art, found any motivation to combine any of said prior art which teaches a "discriminating means for discriminating whether a limit print is performed or not; and means for transmitting the mail to a transmitting source or a reply destination if it is determined by said discriminating means that the limit print is not performed, and wherein the mail is printed up to a predetermined

amount if it is determined by said limiting means and said discriminating means that the limit print is performed".

With respect to claims 9, 19, 29, and 39, the Examiner found neither prior art cited in its entirety, nor based on the prior art, found any motivation to combine any of said prior art which teaches a "discriminating means for discriminating whether a limit print is performed or not, and wherein if it is determined by said discriminating means that the limit print is performed and the E-mail exceeds a predetermined amount, said limiting means does not print the E-mail, if it is determined by said discriminating means that the limit print is performed and the E-mail does not exceed the predetermined amount, said limiting means prints the E-mail, and if it is determined by said discriminating means that the limit print is not performed, said limiting means prints the E-mail".

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is 703-305-8733. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or Faxed to:

(703) 872-9314 (for Technology Center 2600 only).

Hand-delivered responses should be brought to:
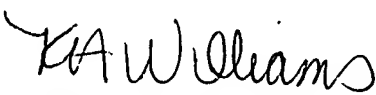Crystal Park II
2121 Crystal Drive
Arlington, VA   Sixth Floor (Receptionist).

TJL

KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER